

REMARKS

To expedite prosecution, Claims 29 and 34-40 have been amended without prejudice or disclaimer. As so amended, the claims deal with the use of the 1,3-dibromo-5,5-dialkylhydantoin group of microbiocides of the original claims in sanitizing poultry, and as to this group of microbiocides for this use, Claims 29 and 34-40 are of the same scope as originally presented. In addition, newly added Claims 41 through 54 are based on original Claims 1, 9-15, and 23 to 28, respectively. Claims 41 through 54 omit the subject matter of these original claims that has been found by the Examiner to constitute independent and distinct subject matter as compared to that presently claimed. Thus here again, there has been no limitation with respect to the subject matter being claimed in this application.

Accordingly, Claims 29 and 34-54 are in the case. Claims 1-28 and 30-33 have been cancelled without prejudice or disclaimer.

As will be seen from the ensuing remarks, it is believed that the claims now in the case are in condition for prompt allowance. Accordingly, reconsideration of the rejections in light of the following remarks is requested.

Before discussing the individual rejections, it is to be noted that no *prima facie* case of obviousness exists with respect to the subject matter of the present claims. Thus, it is submitted that the claims should be allowed.

The rejection of Claim 29 under 35 USC 103(a) on Perkins (6,605,253) in view of Aushincloss (4,822,512) is inapplicable. The reference neither discloses or suggests any hydantoin of the present claims. The reasons given in support of the rejection all relate to sulfamate which is not found in the present claims.

The rejection of Claims 29-40 under 35 USC 103(a) on Hill (4,770,844) in view of Padilla (1,139,188) is also inapplicable. The reference neither discloses or suggests any dibromohydantoin of the present claims. Moreover, the rationale given for the rejection is

inapplicable since the present claims do not involve control of the germs found in poultry that is destined for slaughter. Instead, the present claims involve treating the carcasses or parts thereof using microbiocides not taught or suggested in these references.

The rejection of Claims 29-40 under 35 USC 103(a) over Howarth (6,565,868) or Moore (6,652,889) in view of Perkins (6,605,253) is also inapplicable. The primary references, Moore and Howarth, have a common Assignee with the present application and Moore and Howarth constitute prior art only under 35 USC 102(e). Since the present application was filed on or after November 29, 1999, and since the subject matter of Moore and Howarth and the presently-claimed invention were owned or subject to an obligation to assign the invention to the Albemarle Corporation, Moore and Howarth are disqualified as §103 references. Please see in this regard 35 U.S.C. §103(c).

However, the Examiner's attention is invited to WO 01/53209 A2 of Howarth et al., listed on Applicant's Fifth Supplemental Information Disclosure Statement filed herewith. WO 01/53209 discloses microbiological control in water systems using 1,3-dibromo-5,5-dimethylhydantoin. This document is deemed not to be an applicable prior art reference against the present invention, since its publication date is later than the filing date of U.S. Appln. No. 09/893,581 of which the present application is a CIP. The parent application has been reviewed and Applicant is satisfied that subject matter of the generic claims of the present invention is completely disclosed in the prior application. As for dependant claims, especially those relating to specific pathogens, all species of microbes except *Shigella sonnei* are also discussed in the parent application. Since WO 01/53209, which teaches generic disinfecting methods for a number of organisms, does not disclose or mention *Shigella sonnei*, the reference is deemed to be completely inapplicable to the present case.

The rejection of Claims 29-40 under the judicially-created doctrine of obviousness-type double patenting over Claims 7-20 of Moore et al. U.S. Pat. No. 6,652,889 in view of Perkins (6,605,253) is also inapplicable. It can be seen that the Moore et al. claims do not deal with the brominated hydantoin microbiocides of the present claims. Instead, the Moore claims are directed to substances formed from bromine chloride or from a combination of

bromine chloride and bromine, and which are stabilized with a sulfamate. Thus, even if one were to read the sanitized water claims of Moore in light of the disclosure of Perkins, the result is an entirely different process from the subject matter of the present claims. Quite simply, the inventions claimed in Moore and in the present application are entirely different and there is no double patenting. In this connection, it is noted that the Action at the top of page 8 refers to utilizing the sanitized water of "Howarth" in the process of Perkins. First of all, since the double-patenting rejection is based on Moore rather than Howarth, it is believed that the Examiner intended to refer to Moore rather than Howarth. Secondly, this conclusion in the Action is incorrect since the suggested double-patenting has nothing to do with the use of the Moore process in claims of Perkins.

Claims 29-40 have also been rejected under the judicially-created doctrine of obviousness double patenting over claims 23-34 of U.S. Pat. No. 6,565,868 ('868 patent) in view of Perkins (6,605,253). A terminal disclaimer relative to the '868 patent is submitted herewith thereby rendering the rejection inapplicable. It is to be noted that the filing of such terminal disclaimer does not in any way constitute acknowledgment by applicant as to the correctness of the rejection. Instead, the terminal disclaimer is submitted merely to expedite prosecution of this application. Authorization for payment of the relevant fee is submitted herewith.

From the above remarks, it is believed clear that no *prima facie* case of unpatentability has been established. Nevertheless, as previously noted, the data in the specification shows that 1,3-dibromo-5,5-dimethylhydantoin exhibited excellent effectiveness in control of various microorganisms and also did not adversely affect either the taste or the skin color of the poultry treated therewith. Nothing in the cited prior art suggests that a 1,3-dibromo-5,5-dialkylhydantoin could provide such highly advantageous results. The presently-claimed invention as a whole constitutes nonobvious subject matter.

Newly added Claims 41-54 are deemed patentable for the same reasons as presented hereinabove, and therefore these newly-added claims are also believed to be in condition for allowance. Accordingly, favorable Action thereon is solicited.

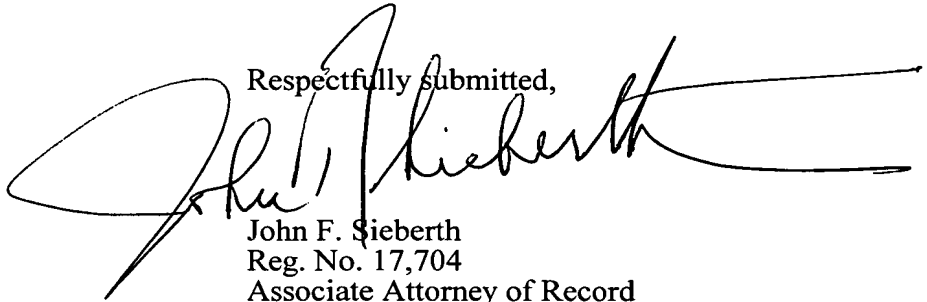


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For reasons given above, it is believed that on reconsideration, the rejections should all be withdrawn and the case passed to issue. If, however, any matters remain in requiring further consideration, the Examiner is respectfully requested to telephone the undersigned so that such matters can be discussed, and if possible, promptly resolved.

Please continue to address all correspondence in this Application to Mr. Edgar E. Spielman, Jr. at the address of record.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that in accordance with standard business practice, this paper (along with any referred to as being attached or enclosed) is to be deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

July 20, 2004
Date

Albert B. Bury